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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 10/046,019  | 01/11/2002  | Jean-Francois Courtoy | 78200-040           | 5197             |
| 7590 11-25/2003<br>Norris, McLaughlin & Marcus, P.A.<br>721 Route 202-206<br>P.O. Box 1018<br>Somerville, NJ 08876-1018 |             |                       | EXAMINER<br>VO. HAI |                  |
|   |             |                       | ART UNIT<br>1771    | PAPER NUMBER     |

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,019

Applicant(s)

COURTOY ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 and 37-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-36 and 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 31-36 in the amendment received on Paper No. 5 is acknowledged. The traverse is on the grounds that there is no undue burden on the Examiner to search both the product claim and the method claims in this present application. This is not found persuasive because a search of Group I would not include the search for Group II.

The restriction requirement is deemed proper and is therefore made FINAL.

2. Applicants are reminded of their right to request rejoinder of method claims with the product claims upon indication of the product claims as being allowable. See In re Ochiai 37 USPQ2d 1127.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 46, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 46-48 contain improper Markush language in accordance with US Patent Practice. The term "or ", line 3, should be preferably changed to --and--.

***Claim Objections***

5. Claims 46 and 47 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that the second mechanically embossed texture is not different from the first mechanically embossed texture based on limitations recited in claims 46 and 47.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
7. Claims 31-33, 35, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtoy et al (Re 33, 599) in view of Baskin (US 4,877,656). Courtoy teaches each and every element of the claimed subject matter except the first mechanically embossed texture having relatively deep emboss depths as compared with a matting grain. Since the claims are unspecific about a structural pattern of the second mechanically embossed texture, figure 6 of Courtoy reads on the limitations of claim 33 (the wear layer which is not disposed over the ink

has a texture different from the first mechanically embossed texture , i.e., a portion of the wear layer located between "chemical embossed" and "mechanical embossed"). Baskin teaches a method of fabricating simulated stone surfaces having relatively deep emboss depths on the substrate (abstract, figure 2B). Therefore, it would have been obvious to one having ordinary skill at the time the invention was made to form artificial high gloss stone on the cured layer overlaying the foamed plastic layer and ink motivated by desire to provide the surface covering with a texture finish.

8. Claims 31-36, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (US 6,555,216) as evidenced by Courtoy et al (Re 33, 599). Chen teaches a surface covering comprising a substrate, a foam layer, and a design layer wherein the design layer includes a portion of a pattern printed with a foaming inhibitor. Chen discloses the surface covering further comprising a strengthening layer, which reads on Applicants' plastic layer overlaying the substrate. Chen teaches a wear layer being provided on top of the design layer and mechanically embossed to form a mechanically embossed portion with a surface texture selected from the group consisting of wood, stone, marble, granite and brick (column 3, lines 10-30). Chen discloses the wear layer being chemically embossed (figures 10). Chen teaches a urethane top coat overlaying the wear layer (figure 11, column 16, line 1). Since the claims are unspecific about a structural pattern of the second mechanically embossed texture, figures 10 and 11 of Chen read on the limitations of claim 33 (the wear

layer which is not disposed over the ink has a texture different from the first mechanically embossed texture, i.e., a portion of the wear layer located between "chemical embossed" and "mechanical embossed"). Chen discloses the design layer being formed by a non-retarder ink composition (column 13, lines 35-36). Chen does not specifically disclose the non-retarder ink composition containing a photoinitiator. Courtoy is relied on as evidence that teaches the ink composition comprising a photoinitiator (column 5, lines 40-42). Thus, it would have been obvious to one having ordinary skill at the time the invention was made to employ the photoinitiator in the design layer because such is an intended use of the material and Courtoy provides necessary details to practice the invention of Chen.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtoy et al (Re 33, 599) in view of Baskin (US 4,877,656), as applied to claim 31 above, further in view of Haemer et al (US 4,298,646). Courtoy does not specifically disclose a polyurethane coating overlaying the cured coating. Haemer teaches a surface covering comprising a polyurethane coating 18

overlaying the cured coating 16 to provide the covering surface more resistance to changes under future conditions (figures 1-2). Thus, it would have been obvious to one having ordinary skill at the time the invention was made to apply a polyurethane coating onto the cured coating of Courtoy motivated by desire to provide the surface covering more resistance to changes under future conditions.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 31-33, 35, 46 and 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. Re 33,599 in view of Baskin (US 4,877,656). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons as set forth in the paragraph no. 6, which are believed to be pertinent.

### ***Response to Arguments***

13. The art rejections in the Office Action mailed on 05/30/2003 have been overcome by the present amendment.
14. Applicant's arguments with respect to claims 31-36 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV



TERREL MORRIS  
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